

REMARKS

Entry of the foregoing, reexamination and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.112, and in light of the remarks which follow are respectfully requested.

Claims 2, 12, 25, 38, 43 and 48 have been amended in response to issues raised in the Office Action. Claim 51 has been added. Claims 1-51 are now pending in this application.

Claims 1-50 have been rejected under 35 U.S.C. §112, second paragraph, for reasons set forth in paragraph 1 of the Office Action. Reconsideration of the rejection is requested in view of the following comments.

According to Section 2173.02, MPEP, the Examiner's focus during examination of claims for compliance with the requirements of 35 U.S.C. §112, second paragraph, is whether the claim meets the threshold requirements for clarity and precision. Definiteness of claim language is analyzed in light of the disclosure and the interpretation given by those of ordinary skill in the art.

The Office Action objects to the words "high" and "low" as being subjective. The word "high" is used in conjunction with the word "gloss". High gloss is defined on page 2, lines 24-28 of the disclosure. The word "low" is used in conjunction with the word "liposolubility". Low liposolubility is defined on page 18, lines 10-11, i.e., sparingly soluble or insoluble in the media used in the octanol test. The words "high" and "low" are defined in the disclosure and their meaning would be clearly understood by those skilled in the art. Therefore, the scope of the claims is submitted to be clear and definite.

The dependencies of claims 38 and 48 have been corrected. Applicants appreciate the Examiner's attentiveness in calling this matter to their attention.

The words "solid" and "non-solid" have been objected to because "Applicants have failed to specify the conditions under which the physical states exist." These terms are discussed on page 18, lines 3-13 of the disclosure and it is clear from the disclosure that the word "solid" and "non-solid" are used by Applicants in the normal sense as defined in any dictionary, i.e., a material which is of a definite shape (solid) or one which is not of definite shape (i.e., liquid or gas). Applicants respectfully submit that those of ordinary skill in the art would have no problem in understanding the scope of these terms.

Claim 12 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for reasons set forth in paragraph 2 of the Office Action. Applicants submit that the claim in its amended form is free of the objection raised in the Office Action.

Claims 15, 16, 41 and 42 have been rejected under 35 U.S.C. §112, second paragraph, as indefinite for reasons set forth in paragraph 3 of the Office Action. Claims 1 and 25 include, *inter alia*, an isocyanate which is at least partially masked by one or more masking agents. Claims 15-16 and 41-42 describe the feature wherein an additional masked isocyanate is present, i.e., one having a specified polymethylene chain. Applicants respectfully submit that the scope of the claims is clear and definite.

Claims 2 and 25-50 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for reasons set forth in paragraph 4 of the Office Action. Applicants respectfully submit that these claims as amended, are free of the objections raised in the Office Action.

Claims 2 and 43 have been rejected under 35 U.S.C. §112, second paragraph, for reasons set forth in paragraphs 6 and 7 of the Office Action. It is submitted that these claims in their amended form are free of the objections raised by the Examiner.

Claims 1-50 have been rejected under 35 U.S.C. §112, first paragraph, for reasons set forth in paragraph 8 of the Office Action. Reconsideration of this rejection is requested in view of the following.

A determination of the propriety of a rejection based on the scope of a claim relative to the scope of enablement involves two stages of inquiry. The first is to determine how broad the claim is with respect to the disclosure considering the entire claim. The second is to determine if one skilled in the art is enabled to make and use the entire scope of the invention without undue experimentation. Section 2164.08, MPEP. With these principles in mind, it is clear that the Summary of the Invention in its broadest aspect is discussed on page 4 lines 2-8 of the disclosure and is set forth in claim 1. Applicants submit that those of ordinary skill in the art would be able to practice the invention as defined in claim 1 from the description in the disclosure. The additional features discussed on page 4, lines 9-26 relate to preferred embodiments of the invention. Features of an invention which are merely preferred are not considered critical. *In re Goffe*, 542F.2d, 564; 191 USPQ 429 (CCPA 1976). The use of an isocyanate having a glass transition temperature of about 20°C or more is merely a preferred embodiment of the invention as discussed in the disclosure. No reasons have been given in the Office Action as to why those of ordinary skill in the art would be unable to understand and practice the invention as defined in claims

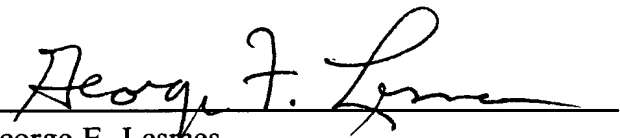
1 and 25 as presently amended. Accordingly, withdrawal of this rejection is respectfully requested.

Paragraph 5 of the Office Action comments on the lack of an English abstract for a publication submitted in the Information Disclosure Statement filed January 16, 2001. To complete the record, Applicants are submitting herewith a copy of an English language abstract of German Patent No. DE 3232463.

In view of the above amendments and remarks, Applicants submit that this application is now in allowable condition. An early and favorable indication to that effect is earnestly solicited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
George F. Lesmes
Registration No. 19,995

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: October 16, 2001



Attachment to Amendment dated October 16, 2001

Marked-up Claims -

2. (Amended) The composition according to claim 1, [wherein the] having a content of tinII salts [is] lower than 0.4% by weight, and having a carboxylic acid function with the proviso that, when carboxylic acid in a [which is] free form or in the form of a salt [is] has an acid number greater than 30 [mg KOH/g], the amine content is less than 0.6% (equivalent) of the total isocyanate function (masked and free).

12. (Amended) The composition according to claim [1] 9, having a particle size wherein a d80 is about 200 micrometers or less, and a d10 is about 20 micrometers or more.

25. (Amended) A composition useful for obtaining a high gloss coating, comprising:

an isocyanate which is at least partially masked by one or more masking agent, having a glass transition temperature of about [20°C] 10°C or more; and

a polyol having a glass transition temperature of about 40°C or more, a hydroxyl number of 20 [mg KOH/g] or more and an average molecular weight Mn of about 500 g/mol or more;

wherein at least one of the following conditions apply:

- the composition further comprises a carboxylic acid function, with the proviso that, when the carboxylic acid function which is free or in the form

Attachment to Amendment dated October 16, 2001

Marked-up Claims -

- of a salt, [is] has an acid number greater than 30 [mg KOH/g], the amine content is lower than 0.6% (equivalent) of the isocyanate (masked and free);
- the composition is essentially free of an esterification catalyst which is solid and/or non-liposoluble;
 - the composition is essentially free of a matt-effect wax; and
 - the composition further comprises a liposoluble catalyst.

38. (Amended) The composition according to claim [35] 25, said composition being in the form of a powder having a particle size wherein a d90 is about 200 micrometers or less.

43. (Amended) The composition according to claim 25, wherein the glass transition temperature (Tg) of the isocyanate is greater than [10°C] 20°C.

48. (Amended) A paint composition comprising the composition according to claim [23] 25, wherein the paint is a high gloss paint.

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DIALOG(R)File 351:Derwent WPI

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WPI Acc No: 1984-057239/198410

Carboxyl gp.-contg. blocked polyisocyanate hardener - for binder contg.
hydroxyl gp.-contg. polymer and polyepoxide esp. for producing mat
coatings

Patent Assignee: BAYER AG (FARB)

Inventor: CLEUR E; HOHL E; KREUDER H J; MEYER R V; RUDOLPH H

Number of Countries: 012 Number of Patents: 006

Patent Family:

Patent No	Kind	Date	Applicat No	Kind	Date	Week
DE 3232463	A	19840301	DE 3232463	A	19820901	198410 B
EP 104424	A	19840404	EP 83108251	A	19830822	198415
JP 59062674	A	19840410	JP 83157285	A	19830830	198420
ES 8500967	A	19850201			198513	
EP 104424	B	19880615			198824	
DE 3377065	G	19880721			198830	

Priority Applications (No Type Date): DE 3232463 A 19820901

Cited Patents: A3...8538; DE 2708611; EP 56167; FR 2283935; No-SR.Pub

Patent Details:

Patent No Kind Lan Pg Main IPC Filing Notes

DE 3232463 A 25

EP 104424 A G

Designated States (Regional): AT BE CH DE FR GB IT LI NL SE

EP 104424 B G

Designated States (Regional): AT BE CH DE FR GB IT LI NL SE

Abstract (Basic): EP 104424 A

The use of compounds containing more than one blocked isocyanate group per molecule and having an acid value of 20 to 150 and a quotient Q of NCO content (based on the sum of free and reversibly blocked isocyanate groups) and acid values of 0.075 to 0.340 as hardeners for binders, more especially for binders of powder-form coating compositions, containing hydroxyl-containing polymers and polyepoxides in quantities corresponding to an epoxide/carboxyl ratio of 0.75 to 1.25.

(9pp)

DE 3232463 A

Hardener has acid no. 20-150 (25-80) and ratio, (Q), NCO content :
acid no. 0.075-0.34 (0.1-0.3).

The hardeners pref. have formula $(\text{HOOC})_m\text{-X-}((\text{OOC-NH}))_n\text{-R}$
($\text{NH-CO-Z})_p\text{-q}$) (I) (where X is an organic gp. having valency $(q.n+m)$; R is an organic gp. having valency $n+p$; Z is the residue of an isocyanate-blocking agent ZH; m is no. 1-3; n is no. 1-4; p is no. 1-5 and q is no. 1-4; provided $p+q$ is over 2). The hardeners can be prepd. from polyisocyanates contg. $n+p$ NCO gps., hydroxycarboxylic acids contg. n OH and m COOH gps. and isocyanate-blocking agnets ZH, esp. caprolactam.

The binders are used esp. for powdered coating compsns. as well as

solvent-contg. lacquer systems. Uniform mat surfaces are obt'd., e.g.
having degree of gloss 30 or less, measured at an angle of 60 deg.
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Abstract (Equivalent): EP 104424 B

The use of compounds containing more than one blocked isocyanate group per molecule and having an acid value of 20 to 150 and a quotient Q of NCO content (based on the sum of free and reversibly blocked isocyanate groups) and acid values of 0.075 to 0.340 as hardeners for binders, more especially for binders of powder-form coating compositions, containing hydroxyl-containing polymers and polyepoxides in quantities corresponding to an epoxide/carboxyl ratio of 0.75 to 1.25.

Derwent Class: A25; A82; E19; G02

International Patent Class (Additional): C08G-018/42; C08G-059/40;

C08K-005/29; C09D-003/64; C09D-005/42

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1 Select Statement(s), 1 Search Term(s)

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\$12.02 Estimated cost File351

\$0.19 TELNET

\$12.21 Estimated cost this search

\$12.47 Estimated total session cost 0.395 DialUnits

Status: Signed Off. (1 minutes)